



Paper No. 9

ARNOLD WHITE & DURKEE
P.O. BOX 4433
HOUSTON, TX 77210-4433

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In re Application of
Zhang, Thwin, Wu, Cho, and Gallagher
Application No. 09/203,078
Filed: 1 December, 1998
Attorney Docket No. INRP:081

SPECIAL PROGRAMS OFFICE
DAC FOR PATENTS

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: DECISION REFUSING STATUS
: UNDER 37 CFR 1.47(a)
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This is in response to the renewed petition under 37 CFR 1.47(a) filed on 2 August, 2000.

The petition is again **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on 1 December, 1998, without an executed oath or declaration and naming Shuyuan Zhang, Capucine Thwin, Zheng Wu, Toohyon Cho, and Shawn Gallagher as joint inventors.

Accordingly, on 15 April, 1999, a "Notice To File Missing Parts Of Application" was mailed, requiring an executed oath or declaration, a filing fee and additional claim fees, and a surcharge for late filing. The petition to accord 37 CFR 1.47(a) status filed on 15 April, 1999, was dismissed in a decision mailed on 7 July, 2000.

In response, on 2 August, 2000, a renewed petition was filed under 37 CFR 1.47(a). Petitioner additionally submitted the following: (a) a declaration of facts by Steven L. Highlander dated 28 April, 2000; (b) a copy of the cover letter dated

31 March, 1999, transmitting the application to the non-signing inventor; (c) a copy of the Federal Express airbill transmitting the application to the non-signing inventor's last known address, dated 31 March, 1999, and from Federal Express back to petitioner's counsel, dated 2 April, 1999, and (d) a declaration of facts by Chuck Landrum dated 27 July, 2000, stating, *inter alia*, that Dr. Cho's last known address is 874 Yorkchester, #102, Houston, TX 77079.

The petition states that a copy of the application papers were forwarded by Federal Express to Dr. Cho's last-known address on 31 March, 1999, but were returned as undeliverable.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee; and
- (4) a statement of the last known address of the non-signing inventor.

The petition lacks items (1) and (2). In regards to requirement (1), petitioner has not submitted sufficient evidence to show that diligent efforts have been made to locate the non-signing inventor. The showing of record, a single mailing to the last known address, is insufficient to prove that diligent efforts were made to locate the non-signing inventor.¹ Petitioner should explain what attempts were made to obtain a forwarding address and to locate the inventor through other means. A brief Internet search suggests that Dr. Cho may currently reside at a different address in the Houston, TX area. If attempts to obtain a forwarding address and to locate the inventor by other means (e.g. though e-mail, Internet searches or the telephone) continue to fail, then applicant will have established that the inventor cannot be reached. Details of the efforts made to locate the non-signing inventor should be set forth in an affidavit or declaration of facts by a person having *first hand* knowledge of the details. The specific dates and times that the application was mailed and other attempts, such as telephone calls or e-mail searches, were made should be included.

Additionally, if it is determined that Dr. Cho is now residing at a different address, a current statement of the last known address must be provided in any request for reconsideration.

¹ See MPEP 403.03(d).

In regards to requirement (2), petitioner has not submitted an oath or declaration listing the residence, post office address, and citizenship for the non-signing inventor² as required by the Decision Refusing Status mailed on 7 July, 2000. Petitioner must submit a new oath or declaration including the above-referenced information. It should be noted that, although petitioner states that Dr. Cho refuses to sign the declaration for Application No. 08/975,519 after receiving a copy of the application papers for that application, petitioner cannot file the declaration from Application No. 08/975,519 in the present application or obtain Rule 47 status based on the grant of Rule 47 status in Application No. 08/975,519 because the present application is a continuation-in-part, not a continuation or division, application of Application No. 08/975,519.³

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries related to this decision should be directed to Petitions Attorney Douglas I. Wood at 703-308-6918.



Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

²37 CFR 1.63 and MPEP 409.03(b).

³37 CFR 1.63(d)(1)(iv) and MPEP 602.05(a).